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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/011,797	07/23/1998	MARC PARMENTIER	VANMA72.001A	1370

7590 12/18/2002

KATHLEEN M. WILLIAMS, ESQ.
PALMER & DODGE, LLP
ONE BEACON STREET
BOSTON, MA 02108-3190

EXAMINER

MURPHY, JOSEPH F

ART UNIT PAPER NUMBER

1646

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/011,797

Applicant(s)

PARMENTIER ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35,37,38,40-42,47 and 59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37,41 and 42 is/are allowed.
- 6) ☒ Claim(s) 35,38,40,47 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Formal Matters

Claim 39 was cancelled and claims 51 and 52 were amended in Paper No. 24, 4/25/2002. Claims 51-52 were cancelled in Paper no. 25, 10/7/2002. Claims 35, 37-38, 40-42, 47, 59 are pending.

Specification

According to 37 CFR 1.821(d) (MPEP § 2422), Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO: " in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application, Sequences appear on page 11, lines 7-10, of the specification but are not identified by SEQ ID NO as required.

Appropriate correction is required.

Response to Amendment

The rejection of claim 40 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,837,809 (Grandy et al. 1998) has been withdrawn based on Applicant's amendment.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 40, 47, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,837,809 (Grandy et al. 1998). U.S. Patent No. 5,837,809 has a priority date of Aug. 11, 1995.

Grandy et al. discloses ligands for a mammalian opioid receptor. One of the ligands disclosed as SEQ ID NO: 5 by Grandy et al. is 100% identical to the polypeptide with an amino acid sequence set forth in SEQ ID NO: 2 (see Sequence Comparison A; also see column 18, lines 51-53). Grady et al. discloses that the peptide can be produced by molecular or genetic engineering means (column 9, lines 27-28). Transformed host cells comprising vectors encoding the protein are disclosed at column 10, lines 45-50. Thus it would have been obvious to one of

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skill in the art at the time the invention to make a nucleic acid encoding the peptide of SEQ ID NO: 2. The motivation is provided at column 10, line 65 to column 11 line 13 which teaches that The recombinant expression constructs of the present invention are useful to transform cells which do not ordinarily express an opioid receptor to thereafter express the receptor. Such cells are useful as intermediates for making cell membrane preparations useful for receptor binding activity assays, which are in turn useful for drug screening. The recombinant expression constructs of the present invention thus provide a method for obtaining reagents for screening potentially useful drugs at advantageously lower cost than conventional animal screening protocols.

Conclusion

Claims 37, 41-42 are allowable.

Claims 35, 38, 40, 47, 59 are rejected.

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Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245.

The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
December 17, 2002